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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,403	07/16/2003	Eric M. King	1870A1	9551

7590 04/27/2005

PPG Industries, Inc.  
Law-Intellectual Property-39SW  
One PPG Place  
Pittsburgh, PA 15272

EXAMINER

BRUNSMAN, DAVID M

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/620,403

Applicant(s)

KING ET AL.

Examiner

David M. Brunzman

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-56 is/are pending in the application.
- 4a) Of the above claim(s) 19-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 13, 14 and 51 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6-9 and 15-17 is/are rejected.
- 7) ☒ Claim(s) 3-5, 10, 11, 18 and 52-56 is/are objected to.
- 8) ☒ Claim(s) 1-11 and 13-56 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20041103 20050207
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 1755

This application contains claims 19-50 drawn to an invention nonelected with traverse in Paper No. 03 November 2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant's election with traverse of group I is acknowledged. The traversal is on the ground(s) that groups I and II should be considered combination/subcombination and do not show 2-way distinctness and, the composition of group I would not form a self supporting film. This is not found persuasive because Groups I and II are related as product and process of use, a combination/subcombination analysis would require both groups be product claims. The composition would be expected to form a self-supporting film as the major ingredient, the silane coupling agent, is known to form monolithic articles. Furthermore, the ability of the composition to form a self-supporting film is moot in view of the prior art relied upon below which teaches that the compositions of claim one are useful in processes for forming coated articles wherein the composition forms a topcoat alone.

Applicant argues groups I and III/IV should have been analyzed as combination/subcombination and do not show two-way distinctness. This is not found persuasive as groups I and III/IV are related as intermediate final product since the composition of group I undergoes a curing step wherein the composition undergoes chemical and physical changes and the material bonds to the substrate. Thus, the identity of the coating composition material is materially changes.

Arguments with respect to the restriction among groups II-IV are held in abeyance in view of the election of group I.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1755

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6-9 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka et al.

Example 1 of the reference teaches a coating composition containing 31% of a methyltrimethoxysilane hydrolysate, acetic and hydrochloric acids, solvents and a diglycidyl bisphenol A resin (EPIKOTE-827). Instant claim 2 limits the coupling agent of claim 1. Methyltrimethoxysilane falls within the scope of claim 2. Claim 1 includes at least partial hydrolysates of said coupling agent. Methyltrimethoxysilane of the reference also anticipates the materials recited in claims 15-17. The intended use of the composition fails to patentably distinguish the composition itself for the intended topcoats of the prior art.

Claims 51, 13 and 14 stand allowable over the prior art of record for the reasons set forth in the previous office action. Claims 3-5 and 52-56 are objected to but, would be allowable over the prior art of record if rewritten in independent form because the prior art is limited to compositions of polymeric epoxy materials. Claims 10, 11 and 18 are objected to but, would be allowable over the prior art of record if rewritten in independent form because the prior art does not teach the use of catalysts that generate acid upon exposure to actinic radiation with coating compositions containing epoxy materials in addition to the coupling agent.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until

Art Unit: 1755

after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Brunzman whose telephone number is 571-272-1365. The examiner can normally be reached on M, W, F, Sa; 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David M Brunzman  
Primary Examiner  
Art Unit 1755

A handwritten signature in black ink, appearing to be 'DMB', written over a horizontal line.

DMB